

REMARKS

Applicants gratefully thank the Examiner for acknowledging both the claim for foreign priority in this Application as well as the previously-filed Information Disclosure Statements.

In response to the Final Office action dated April 15, 2010, Applicants respectfully request reconsideration based on the amendments herein and at least the following remarks. Applicants submit that the claims as presented herein are in condition for allowance.

Claims 1-25 are pending in the present application (claims 1 and 13 being independent). Claims 13 and 25 have been amended herein. Claims 1-12 were previously withdrawn, and claim 23 has been cancelled herein leaving claims 1-22, 24 and 25 pending for reconsideration.

Applicants acknowledge the indication of allowable subject matter as discussed in more detail below. Specifically, claims 23-25 were not objected to or rejected in the Final Office action. The elements of claim 23 have been incorporated into independent claim 13. In addition, elements of claim 25 were also incorporated into independent claim 13.

No new matter has been added by the amendments or new claims. Specifically, claim 13 has been amended only to include the material of dependent claim 23 and elements of dependent claim 25.

Applicants respectfully request reconsideration of claims 13-22 and 23-25 based upon the amendments and at least the following remarks.

Teleconference Summary

Applicants thank the Examiner for the opportunity to conduct an interview with Applicants' attorney, John Stankiewicz, on June 23, 2010. During the interview, Applicants indicated that claims 23-25 were not rejected in the Final Office action. Thus, claims 23-25 are presumed to contain allowable subject matter. Claim 13 has

been amended to include the allowable subject matter of dependent claim 23 and portions of the subject matter of dependent claim 25.

Claim Rejections Under 35 U.S.C. §102

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Bariant, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Furthermore, the single source must disclose all of the claimed elements “*arranged as in the claim.*” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984) (Emphasis added).

Claims 13-19 and 22 are rejected under 35 U.S.C. 102(b) as being allegedly anticipated by Besenhard et al. (U.S. Pat. 5,916,485, hereinafter “Besenhard.”) Applicants respectfully traverse for at least the following reasons.

Applicants respectfully note that Besenhard teaches, primarily at columns 7 and 8, the SIC coating method onto non-conductive fibers or powders to introduce conductivity into those fibers or powders, and thus obtain conductive particles, which may then be used as a conductive material. Besenhard is completely silent, however, regarding, for example, using the SIC coating method to deposit active and/or conductive layers (or a composite layer thereof) onto the surface of an electrode substrate.

In contrast and in accordance with the present invention, as specifically recited in as-filed claim 13, the SIC coating method is used to deposit active and/or conductive layers (or a composite layer thereof) onto the electrode substrate, to produce an electrode having a substantially thinner and/or uniform active material layer, conductive material layer, or composite layer thereof. Moreover, as noted by the Applicants at page 3, lines 21-23 of the as-filed application, “no example exists of preparing an electrode where layers of active material and conductive material are formed on the surface of an electrode substrate using the SIC coating method.”

Thus, the coating target of the SIC coating method of the present invention differs over that of Besenhard, resulting in an electrode having a thinner (and more uniform) thickness of the active material layer, the conductive material layer, and/or the composite layer, thereby providing superior electro-chemical performance of the electrode according to the present invention.

Therefore, Besenhard does not teach or suggest “preparing a layer of active material, a layer of conductive material, or a composite layer including an active material and a conductive material onto the surface of the electrode substrate using a substrate induced coagulation (SIC) coating method” as in independent claim 13. As a result, Besenhard does not disclose all of the claimed elements arranged as in claim 13.

In addition, Applicants respectfully note that claim 13 has been amended to include the allowable subject matter of dependent claim 23, and is thus allowable for at least the reasons for which claim 23 was not rejected over the cited references.

Thus, it is respectfully submitted that claim 13, including claims depending therefrom, i.e., claims 14-22, 24 and 25, define over Besenhard.

Accordingly, it is respectfully requested that the above rejection to claims 13-19 and 22 under 35 U.S.C. § 102(b) be withdrawn.

Claim Rejections Under 35 U.S.C. § 103

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over determining where the optimum combination of percentages. Specifically, the Examiner states that Besenhard teaches all elements of claims 20 and 21 except “the w/w % of the polyelectrolyte or the amounts of material contained in the dispersion,” which the Examiner further states *prima facie* obvious, in that determining where the optimum combination of percentages is not inventive. Applicants respectfully traverse for at least the following reasons.

Independent claim 13, from which claims 20 and 21 depend, is submitted as being allowable for defining over Besenhard, as discussed above.

Furthermore, it is respectfully submitted that “the w/w % of the polyelectrolyte or the amounts of material contained in the dispersion,” as allegedly would have been obvious, does not cure the deficiencies noted above with respect to Besenhard.

In addition, Applicants respectfully note that claim 13 has been amended to include the allowable subject matter of dependent claim 23, and is thus allowable for at least the reasons for which claim 23 was not rejected over the cited references.

Thus, Applicants respectfully submit that claims 20 and 21 of the present invention are patentable over the cited references. Applicants further respect disagree with the Examiner’s allegation that “the w/w % of the polyelectrolyte or the amounts of material contained in the dispersion” would have been obvious, and hereby respectfully reserve the right to illustrate additional reasons for such non-obviousness, such as criticality of the claimed range, for example, should the need arise.

Accordingly, it is respectfully requested that the rejection of claims 20 and 21 under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

In view of the foregoing remarks distinguishing the prior art of record, Applicants respectfully submit that this application is in condition for allowance. Early notification to this effect is requested. The Examiner is invited to contact Applicants' attorneys at the below-listed telephone number regarding this Amendment or otherwise regarding the present application in order to address any questions or remaining issues concerning the same.

If there are any charges due in connection with this response, including for any added claims and/or any necessary extensions of time under 37 C.F.R. 1.136(a) or 1.136(b), such as for the one-month extension for which the Applicants hereby respectfully petition, please charge them to Deposit Account 06-1130.

Respectfully submitted,

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